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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,299	08/30/1999	ALI MOSLEH	93-3-513	8955
25537 VERIZON PATENT MANAGEMENT GROUP 1515 N. COURTHOUSE ROAD SUITE 500 ARLINGTON, VA 22201-2909	7590 03/18/2008		EXAMINER AL HASHEMI, SANA A	
			ART UNIT 2164	PAPER NUMBER
			NOTIFICATION DATE 03/18/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/385,299

Applicant(s)

MOSLEH ET AL.

Examiner

Sam Rimell

Art Unit

2164

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 30-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 3 and 4 is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-17 and 30-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Preliminary Note: This office action includes new grounds of rejection not necessitated by amendment, and therefore is made non-final.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30-50 are rejected under 35 U.S.C. 101 because the claimed invention is non-statutory.

Claims 30, 32, 36 and 41: Each of claims 30, 32, 36 and 41 refer to a "computer readable medium containing instructions which, when executed by a processor perform a method". The claimed invention is not directed to a processor since the execution by a processor is conditionally recited (i.e. "when executed") and the preamble clearly indicates that the invention is the computer readable medium and not the processor.

Since the "computer readable medium" is recited in the specification as being a carrier wave (page 27, line 20), the claimed invention is directed to a non-statutory category invention, namely, and form of energy. Accordingly, these claims are non-statutory.

Claims 31, 33-35, 37-40, 42-50: Depend from independent claims 30, 32, 36, 41.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5-17, 30-31 and 34-54 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 7, 12, 30, 36 and 41: Each of these claims have been amended to recite the phrase “..channel that is selected by the portable access device based on the communication profile...”. The original specification does not support the concept of making the selection of the medium based on a communication protocol. The relevant discussion appears in the specification at page 9, where it states:

The actual selection of a particular channel will be service dependent and a function of the user's whereabouts, the desired quality of the connection, and the costs of the connection. One of the elements used to determine the selection of a specific channel for communications, either local or wide area, is the available network and its coverage area. The selection will also depend on the destination server's configuration which may include: in campus wired Ethernet LANs, hospital wide wireless Ethernet, wide area wireless networks, and the Public Switched Telephone Network (PSTN) connections using standard modems.

The first sentence makes no mention of using a communications profile as a factor in the selection of a communications channel. The second and third sentences only refer to the general type of destination network, such as a wireless LAN or WAN. The actual profile used on the network is not recited as a deciding factor in selecting the network.

Accordingly, from each of claims 1, 7, 12, 30, 36 and 41 are new matter.

Claims 2, 5-6, 8-11, 13-17, 31, 33-35, 37-40 and 42-50: Depend from the independent claims 1, 7, 12, 30, 36, 41 respectively.

Claim 51: Claim 51 has been newly added and recites "...a second attempt to establish communication via a remote wireless Ethernet network, or a cellular transmission network or a portable radiotelephone transceiver if the first attempt fails..". This feature is not supported in the original specification.

The discussion of the first, second and third attempts are illustrated in FIG. 8, and discussed in the specification at page 25. The relevant discussion from the specification reads as follows:

"If, in step 274, the ICS module 304 determines the wireless LAN is out of range, it attempts to communicate via the cellular network in step 278."

Claim 51 as currently amended now allows the attempts to be made over an Ethernet network and portable radiotelephone transceiver, which are not recognized as options for this procedure in the original specification. Accordingly, the identified quotation in claim 51 is new matter.

Allowable Claims: Claims 3 and 4 are allowed.

Remarks

Applicant's arguments have been considered.

In addressing the rejection of claims 1, 7, 12, 30, 36 and 41 under 35 USC 112, first paragraph, applicant point to the original specification at pages 8, 10-11, 15, 23 and 24. The only one of these quotations which appears to be relevant to the claim language in question is the quotation at pages 10-11, where discussion is made of the ICS module interfacing with a communications profile. However, this discussion does not indicate what the ICS module does with the communication profile once it is received, and does not specify that the profile is a

factor used in the selection of a channel. Accordingly, these features remain to be viewed as new matter.

In addressing the rejection of claim 51 under 35 USC 112, first paragraph, applicant point to a quotation from the specification at page 16. However, the scenario described in this quotation does not match the scenario described in claim 51. The scenario described in the specification refers to a situation where the communication profile is not stored, whereas claim 51 refers to a situation where the communications profile has been identified. Claim 51 has been further amended to address this rejection, but the amendment itself raises issues of new matter.

This office action is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

/Sam Rimell/
Primary Examiner, Art Unit 2164